

Amendment Under 37 C.F.R. § 1.116  
Appln. No.: 09/326,691

### **REMARKS**

Claims 2, 5-7 and 10-12, 18-19, 21 and 23 are all the claims pending in the application. Claims 2, 5-7 and 10-12 are allowed, claims 21 and 23 are objected to and claims 17-19 are rejected.

In the present Amendment, rejected claim 17 is canceled. Additionally, objected to claim 23 is rewritten into independent form. Thus, the present amendment clearly reduces issues for appeal and entry is respectfully requested. Further, it is respectfully submitted that the attached §132 Declaration places claims 18 and 19 in condition for allowance.

#### **I. The Allowable Subject Matter**

Claims 2, 5, 6, 7, 10, 11 and 12 are allowable for the reasons as established in the record

Claims 21 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 23 has been rewritten into independent form, including all of the recitations of independent claim 17. In view thereof, Applicants respectfully submit that claim 23 is in condition for allowance.

**II. The Rejections Under 35 U.S.C. § 102/103**

Claims 17-19 are rejected under 35 U.S.C. §102(b) or (e) as allegedly anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly obvious over EP 070143 (EP ' 143) or J09151279 (Japan '279).

Applicants respectfully submit that the present invention is not anticipated by or obvious over EP 070143 or J09151279 and request that the Examiner reconsider and withdraw these rejections in view of the following remarks.

Claim 17 has been canceled. Claim 18 depends on claim 19.

Applicants respectfully submit that the rubber composition defined by claim 19 is different, in terms of the physical property, and is not obvious from the rubber compositions and teachings of Japan '279 and EP '143. As described in further detail in the Declaration Under 37 C.F.R. §1.132 by Mr. Nishizaki, attached hereto, the rubber composition of Japan '279 (Example 4) has, in a curve exhibiting a change in dynamic storage modulus during elevation of temperature, an intersection of an extrapolation line A of a portion in which the dynamic storage modulus shows an approximately linear change before a rapid decrease at temperatures higher than 100 °C and an extrapolation line B of a portion in which the dynamic storage modulus rapidly decreases, at 90 °C, which is clearly not within the range (170 °C or higher) defined by claim 19 of the present application.

Similarly, the rubber composition of EP '143 (Example 22) has, in a curve exhibiting a change in dynamic storage modulus during elevation of temperature,

the intersection (as described above) at 120 °C, which is clearly not within the range (170 °C or higher) defined by claim 19 of the present application.

Accordingly, it is respectfully submitted that the rubber composition of the present invention, as defined by claim 19, is distinctly different, in terms of physical property, from the rubber compositions of Japan '279 and EP '143.

Further, because Japan '279 and EP '143 are both concerned only with tread rubber (this fact is clear from the rubber compositions thereof), Japan '279 and EP '143 do not provide a motivation to one skilled in the art to change the rubber compositions thereof to reach the present invention.

The presently claimed invention, which achieves an unexpectedly excellent "HTS effect" by using the unique rubber composition thereof for a reinforcing layer and the like, is not anticipated or obvious over the teachings of Japan '279 and EP '143. (The "HTS effect" is obtained by addition of HTS to a rubber composition when the rubber composition is used for a reinforcing layer and the like. See, for example, the summary in the first full paragraph of page 8 of the Amendment dated July 15, 2002).

For the above reasons, it is respectfully submitted that the subject matter of claims 18 and 19 is neither taught by nor made obvious from the disclosures of Japan '279 and EP '143 and it is requested that the rejections under 35 U.S.C. §§102 and 103 be reconsidered and withdrawn.

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### III. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the rejections under 35 U.S.C. §102 and the rejections under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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